

Remarks

Please note: the order of the headings in this Amendment correspond to the order of the headings in the Office Action.

Drawings

A corrected drawing (the proposed drawing correction was already approved), as required by the Office Action, is submitted herewith.

Claim Objections

Claims 1 and 3-12 are objected to by the Examiner in numbered paragraph 4, pages 2 and 3. In actuality, only claims 4 and 8 through 12 noted correction requirements. The required changes to claims 4 and 8 through 12 have been made in this Amendment.

Claim Rejections – 35 USC 112(2)

Claim 1 is amended as the Examiner suggested in numbered paragraph 6.

Claim Rejections – 35 USC 103(a)

Claims 1, 3, 4 and 7-10 stand rejected as being unpatentable over Neuhaus et al (Neuhaus) in view of admitted prior art (See the specification pages 1-2).

Claims 4-6 stand rejected as being unpatentable over Neuhaus and the admitted prior art and further in view of Ueda et al.

Claims 11 and 12 stand rejected as being unpatentable over Neuhaus, the admitted prior art, Veda et al and further, in view of Butler et al.

To establish a *prima facie* case of obviousness under 35 USC 103(a) the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed

Kiener  
(MM)54 039  
US Patent Application 09/746,732

7

to obvious subject matter, either the references must expressly or imply suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” (MPEP 706.02(j))

Amended claim 1 is inventive with respect to Neuhaus in view of the admitted prior art of the specification, pages 1 and 2.

Referring to the admitted prior art on pages 1 and 2 of the specification, the first cited document refers to DE 29 52 322. This document is the priority document for Neuhaus.

The further document cited and discussed on page 2 of the specification, EP 0 726 142 A3, claims the priority of Japanese Patent Application JP 21616/95, which is the same priority document as for Ueda et al. (Ueda).

Thus, the two cited documents in the introduction of the specification are the same two documents cited by the Examiner as prior art. Therefore, the rejection of the Examiner by referring “Neuhaus” and the admitted prior art of the specification is referring to only two documents.

The Examiner states in numbered paragraph 8 on page 4, last paragraph, second line as well as on page 5, first paragraph, line 6 that “Neuhaus discloses a method for forming tamperproof documents by laminating an information carrier with plastic foil on both sides for creating credit cards, company cards, etc.” Those credit cards and company cards are “finished goods” or “end products”, which, after being cut to their appropriate size will not be used for further processing. After laminating, they will have their final shape. Therefore, the plastic foil used for forming such tamperproof

Kiener  
(MM)54 039  
US Patent Application 09/746,732

8

documents are thick and not comparable with the laminate according to the present invention, which is created for further processing and is a component for forming tamperproof documents.

Therefore, the first difference between Neuhaus and the present application is that Neuhaus forms end products.

This will also be obvious according to column 12, lines 37 to 43 of Neuhaus, which describes that the lamination produced by Neuhaus' process is **bonded indissolubly** to the enveloped information carrier and prevents every attempt at subsequent alteration of the information carrier. Once the foil has been applied, it **cannot be removed** without complete destruction of the information carrier.

Thus, Neuhaus only discloses a method for forming tamperproof documents by laminating, and further, in such a way to insure that at least one film bonded on the information carrier cannot be removed without damaging the information carrier. Nothing else is described in the description on page 1, second paragraph of Neuhaus.

The Examiner notes correctly that Neuhaus is silent as to using an information carrier provided on each side with a protective/supporting film that is removed prior to laminating with plastic foil. Since the plastic foil should be bonded indissolubly, Neuhaus has not considered using an information carrier provided on each side with a protective/supporting film that is removed prior to laminating with plastic foil.

Neuhaus' goal was to achieve a laminate that will be destroyed if it is manipulated. Consequently, Neuhaus would not be a basis for combination with documents in view of the following:

1. Neuhaus discloses forming a final product, such as a credit card.

Kiener  
(MM)54 039  
US Patent Application 09/746,732

2. According to Neuhaus' process, the information carrier is enveloped with plastic films in a non-removable manner.

The following discussion pertains to the rejection of Neuhaus in view of Ueda. Applicant respectfully argues that combining Neuhaus with Ueda is not appropriate, as it would not be obvious for a person of ordinary skill in the art to combine these two references. Specifically, combining films that are removed by Ueda's process, which is noted on page 2 of the specification of the present application, with the method for forming a tamperproof document according to Neuhaus is not obvious for the following reasons.

First, Ueda relates to a system for duplicating holograms. Furthermore, Ueda's laminate created by an apparatus according to figure 6a is different from Applicant's claimed invention (see Ueda's figure 6b with reference no. 5).

Additionally, Ueda's procedure for creating the laminate according to reference no. 5 in figure 6b is different from Applicant's claimed invention.

In the following discussion, we refer to figures 6a and 6b with respect to the description in column 7, line 14 to column 8, line 15 of Ueda.

Ueda's process starts with a photosensitive material having a base film on both sides. The base film will be removed from only one side of the photosensitive material. Afterwards, the photosensitive film is laminated on an original plate cylinder by a press cylinder. On the original plate cylinder the photosensitive material is exposed, and the UV exposure part of 46b is used for delaminating the film from the original plate. After the exposure with laser light the delaminated side of the photosensitive material is covered by a special protective film. The protective film consists of two PET-films

Kiener  
(MM)54 039  
US Patent Application 09/746,732

10

interposing an optical adhesive. One of the films is removed, so that the optical adhesive can be laminated to the photosensitive material. After laminating, the laminate is treated by an ultraviolet irradiator.

Ueda's procedure (described above) is not comparable with the present invention's process.

The present invention delaminates at least one supporting film from the at least one polymer film. Afterwards, a substrate is laminated to the protective film by an adhesive layer. This substrate, which is positioned to the polymer film by an adhesive, is directed to the cross-linking-active UV-radiation to harden the adhesive. Afterwards, the same procedure is repeated on the opposite side.

After removing the base film from the photosensitive material, Ueda discloses laminating the photosensitive material to the original plate and delaminating the exposed photosensitive material film from the original plate. Subsequently, a special protective film 50 is laminated to the photosensitive material and afterwards the laminate is treated by an ultraviolet irradiator 42.

Therefore, Ueda's steps for creating a laminate are different from the present invention as claimed. Further, Ueda's assembly of the laminate is different and is made of different films.

Furthermore, according to Ueda, one base film will be kept remaining on the photosensitive material and a special protective film will be laminated on the delaminated side of the photosensitive material film.

Therefore, the Examiner's conclusion according to page 5, first paragraph, lines 10 to 15 is not conceivable.

Kiener  
(MM)54 039  
US Patent Application 09/746,732

11

A man skilled in the art does not get any advice from Ueda – contrary to the opinion of the Examiner on page 5, second paragraph – to provide a laminate according to the invention. Even if a man skilled in the art would omit the exposure by laser light according to a procedure step disclosed by Ueda, the procedure according to the invention would not be obvious.

Furthermore, Ueda's procedure does not disclose delaminating a supporting film on the first side of a polymer film and immediately thereafter removing the support film to laminate a substrate on this side that will be hardened by a UV radiation without hardening the complete semi-final laminate. Ueda discloses only one ultraviolet irradiator for finishing the lamination assembly. Further, Ueda does not disclose that after the first step for substituting the supporting film by a substrate on one side, to subsequently delaminate the supporting film on the second side and afterwards laminate the substrate on the second side to create a laminate that can be used for further processing for forgery-proof documents. Ueda discloses that after delaminating the base film on one side, the remaining film must be laminated with the photosensitive side onto the original plate cylinder 35 whereby the base film is on the outside of the photosensitive film.

Therefore, a subsequent substitution of the supporting film by a substrate on one side after the other is not disclosed by Ueda nor disclosed by the combination of Neuhaus and Ueda.

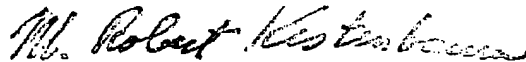
Given the above discussion, Applicant respectfully argues that the present invention, as claimed, should be allowable. Wherefore, further consideration and allowance of the claims is respectfully requested.

Kiener  
(MM)54 039  
US Patent Application 09/746,732

12

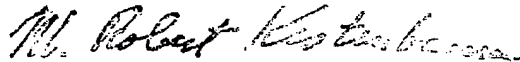
A one-month extension of time in which to respond to the outstanding Office Action is hereby requested. Credit Card Payment Form PTO-2038 is enclosed to cover the prescribed Small Entity one-month extension fee of \$55.00.

Respectfully submitted,



M. Robert Kestenbaum  
Reg. No. 20,430  
11011 Bermuda Dunes NE  
Albuquerque, NM USA 87111  
Telephone (505) 323-0771 Facsimile (505) 323-0865

I hereby certify this correspondence is being submitted to the Commissioner for Patents, Washington, D.C. 20231 by facsimile transmission, fax number (703) 872-9306, on August 18, 2004.



M. Robert Kestenbaum

Kiener  
(MM)54 039  
US Patent Application 09/746,732

13